

RECEIVED
CENTRAL FAX CENTER
JUL 28 2006

REMARKS

New claims 67-73 have been added, above. The specification and claims 12, 48, and 65-66 stand objected to. Claims 1-5, 7-12, 14-19, 21-31, 33-44, 46-57, 59-62, and 64-66 stand rejected upon informalities. Claims 1-5, 7-12, 14-19, 21-31, 33-44, 46-57, 59-62, and 64-66 stand rejected on prior art grounds. Applicants respectfully traverse these rejections based on the following discussion.

I. The Claim Objections

Claims 12, 48, and 65-66 stand objected to because of informalities. Specifically, the Office Action argues that claims 12, 48, and 66 do not further define the structure of the apparatus/system, but merely describe qualities of the coupons acted upon by the system (Office Action, p. 2, item 2). Claims 12, 48, and 66 have been amended, above, to further define the structural elements of the respective claims in which they depend upon. For example, claim 12 defines that said means for determining if said selection of e-coupons complies with redeeming conditions, said means for checking said selection of e-coupons, and said means for displaying said selection of e-coupons are adapted to analyze e-coupons that reside at any one of the group consisting of a user's site, a third party's site, and a site of said a retailer in said networked environment. As such, claim 12 further limits the structural limitations set forth in claim 8, from which claim 12 depends upon.

In addition, the Office Action argues that claim 65 does not further limit the structure of the system, but rather states where such system is located (Office Action, p.

2, item 2). Applicants respectfully disagree with such a conclusion. Applicants submit that defining where the system is located further defines the system. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the objections to the claims.

II. The 35 U.S.C. §112, Second Paragraph, Rejections

Claims 1-5, 7-12, 14-19, 21-31, 33-44, 46-57, 59-62, and 64-66 stand rejected under 35 U.S.C. §112, second paragraph. Specifically, the Office Action argues that the phrase “coupons ... not being mutually exclusive” does not state what qualities in particular of the coupons are not mutually exclusive (Office Action, p. 3, item 4). Claims 1, 8, 15, 22, 27, 28, 30, 36, 41, 42, 44, 49, 54, 55, 57, and 62 have been amended, above, to state what qualities in particular of the coupons are not mutually exclusive.

More specifically, Applicants have amended independent claims 1, 8, 15 to replace “being non-mutually exclusive” with “capable of being used in combination within the same purchase”. Further, Applicants have amended claims 22, 27, 28, 30, 36, 41, 42, 44, 49, 54, 55, 57, and 62 to replace “not being mutually exclusive” with “capable of being used in combination within the same purchase”.

In addition, the Office Action argues that, in regards to claim 34, there is no antecedent basis for “said profile” (Office Action, p. 3, item 4). The term “said user’s profile” has been removed and replaced with “a profile of said user”. The “user” is set forth in independent claim 22, from which claim 34 depends upon, using the following language: “computing a set of applicable e-coupons dependent upon a set of e-coupons

of a user". In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. The Prior Art Rejections

Claims 1-5, 7-12, 14-19, 21-31, 33, 35-44, 46, 48-57, 59, 61-62, and 65-66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski (U.S. Patent No. 6,932,270). Claims 3, 10, 17 (alternatively) and 34, 47, 60, and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, in view of Beach, et al. (U.S. Publication No. 2002/0107738), hereinafter referred to as Beach. Applicants respectfully traverse these rejections based on the following discussion.

The claimed invention provides a method, apparatus, computer program product, system, etc. of determining a combination of electronic coupons (e-coupons) for redemption by a retailer in a networked environment. In the rejection, the Office Action argues that Fajkowski discloses a method of using coupons wherein optimized savings are achieved. However, neither Fajkowski nor Beach, either individually or in combination, teach or suggest defining optimization parameters by a user, checking coupons to determine if they satisfy the user-defined optimization parameters, or displaying only the coupons that satisfy the user-defined optimization parameters. Moreover, neither Fajkowski nor Beach disclose a system comprising an optimization engine that determines a subset of coupons dependent upon optimization parameters. Applicants submit that nothing within Fajkowski mentions optimizing saving using an optimization engine or optimization parameters. Rather, the cited references merely

disclose determining whether coupons meet redemption requirements. Therefore, as explained in greater detail below, Applicants respectfully submit that the prior art of record does not teach or suggest the claimed invention.

Applicants respectfully submit that Fajkowski does not teach or suggest the claimed feature of "checking said selection of e-coupons complying with said redeeming conditions and capable of being used in combination within the same purchase to determine if said selection of coupons satisfy optimization parameters" as defined by independent claims 1, 8, and 15. Further, Fajkowski does not teach or suggest the claimed feature of "displaying only said selection of e-coupons ... that satisfy said optimization parameters" as defined by independent claims 1, 8, 15, 22, 36, and 49.

The Office Action asserts that in response to the Office Action dated December 20, 2005, Applicants appear to argue that some coupons of the instant invention are not displayed merely because they are eligible, but no such limitations are presently in the claims (Office Action, p. 9, para. 2). Applicants submit that the currently amended claims further define that e-coupons are not only displayed because they comply with redeeming conditions, but also because they are capable of being used in combination within the same purchase, and because they satisfy optimization parameters (independent claims 1, 8, 15, 22, 36, and 49). As more fully discussed below, such features are not taught by the cited references.

The Office Action also argues that scenarios are not required to be analyzed by the proposed system based upon Applicants' currently assertedly broad claim language (Office Action, p. 8, para. 2). Applicants submit that the currently amended claims

define a method comprising "checking said selection of e-coupons ... to determine if said selection of coupons satisfy optimization parameters" (independent claims 1, 8, and 15). Further, the currently amended claims define a method comprising "determining if said computed set of e-coupons ... satisfy optimization parameters defined by said user" (independent claims 22, 36, and 49). As more fully discussed below, such features are not taught by the cited references.

Furthermore, the Office Action asserts that Fajkowski need not say that the display of eligible coupons provides coupon optimization; the teachings are "interpreted by the Examiner as meeting the broadly claimed optimization" (Office Action, p. 8, para. 2). More specifically, the Office Action provides an example wherein a customer approaches the point-of-sale with *only* "fully optimized" coupons, wherein "the instant invention would do nothing to the set of coupons ... [because] there were no 'conflicts' to resolve" (Office Action, p. 8, para. 1). Thus, the Office Action states that as long as the claim language is met by a single scenario, then the claim language is met (Office Action, p. 8, para. 2).

Although the Office Action asserts that Fajkowski may display "fully optimized" coupons when these are the only coupons in a customer's possession, Applicants submit that the coupons are not checked to determine whether they satisfy optimization parameters defined by the customer. As more fully described below, nothing within Fajkowski mentions defining optimization parameters or checking coupons to determine whether they satisfy the optimization parameters. Thus, even if "fully optimized" coupons are displayed in the Examiner's example, such coupons are not checked for

optimization parameters, as defined by independent claims 1, 8, 15, 22, 36, and 49.

Therefore, such a scenario would not meet the language of the currently amended claims.

As discussed above, Fajkowski fails to teach or suggest checking a set of coupons for optimization parameters and displaying only coupons that satisfy the optimization parameters. The Office Action argues that if a customer has the proper products at checkout, the displayed coupons represent “optimized savings” (Office Action, bottom of p. 4). Moreover, the Office Action argues that the act of displaying eligible coupons plus near-eligible coupons “demonstrates further optimization” (Office Action, bottom of p. 4).

Applicants respectfully disagree with such a conclusion. Specifically, the fact that a customer has the proper products at checkout and eligible and near-eligible coupons are displayed does not provide optimized savings. Fajkowski does not teach defining optimization parameters by a user, checking coupons to determine if they satisfy the user-defined optimization parameters, or displaying only the coupons that satisfy the user-defined optimization parameters. Moreover, Fajkowski fails to disclose a system comprising an optimization engine that determines a subset of coupons dependent upon optimization parameters. Applicants submit that nothing within Fajkowski mentions optimizing saving using an optimization engine or optimization parameters. Rather, Fajkowski merely discloses determining whether coupons meet redemption requirements.

Conversely, as provided in paragraph 0078 of Applicants’ disclosure, a shopper may query the system 400 to suggest a most favorable combination of coupons, or a close-to-optimal subset(s) of coupons, for the given purchase order. The customer can

choose to optimize based on various parameters. These optimization parameters 422 are used by the optimization engine 420 in comparing the possible subsets of coupons that can be used in the given purchase order. Examples of optimization parameters 422 are the discount amount of the selected coupon set should be maximized, the loyalty points towards a membership should be more than x, the number of free items in discounts should be highest, a particular coupon(s) should not be included in the selected sets, a particular coupon(s) should be included in the selected sets, coupons with earlier expiry time be given higher preference, maximum number of coupons should be used, and the like.

As further provided in paragraph 0079 of Applicants' disclosure, the system 400 first calculates applicable coupons based on the redemption conditions. The system 400 then computes the global optimum or a set of close to optimum solutions, whichever is possible, based on the optimization criteria 422 specified by the shopper and the coupons mutual exclusivity rules.

Applicants submit that nothing within Fajkowski mentions optimizing savings based upon optimization parameters defined by a user. Further, nothing within Fajkowski mentions an optimization engine that determines a subset of coupons dependent upon optimization parameters. Rather, Fajkowski merely discloses determining whether coupons meet redemption requirements. Accordingly, it is Applicants' position that Fajkowski fails to teach or suggest the claimed feature of "checking said selection of e-coupons ... to determine if said selection of coupons satisfy optimization parameters defined by a user", as defined by independent claims 1, 8, and

15 or “determining if said computed set of e-coupons ... satisfy optimization parameters defined by a user” as defined by independent claims 22, 36, and 49. Further, it is Applicants’ position that Fajkowski fails to teach or suggest the claimed feature of “an optimization engine adapted to determine a subset of coupons ... dependent upon optimization parameters” as defined by independent claim 62.

Furthermore, because Fajkowski fails to disclose optimization parameters, and particularly checking for and displaying coupons based upon optimization parameters, it is Applicants’ position that Fajkowski fails to teach or suggest the claimed feature of “optimization parameters comprising at least one of a discount amount, loyalty points, a number of free items received, earmarked coupons, non-earmarked coupons, expiration date, and a total number of coupons used” as defined by independent claims 22, 36, 49 and dependent claims 67, 68, 69, 70.

In addition, the Office Action asserts that “applicant’s claims are devoid of any requirement NOT to display any mutually exclusive [coupons]” (Office Action, p. 8, sentence 2). Applicants have amended independent claims 1, 8, 15, 22, 36, 49, and 62, above, to define that “only said ... e-coupons ... capable of being used in combination within the same purchase” are displayed.

To the contrary, Fajkowski fails to teach determining whether two or more coupons can be used in combination within the same purchase. Therefore, in Fajkowski, the coupons are not analyzed for mutual exclusivity; and, coupons that can NOT be used in combination within the same purchase will be displayed. Thus, numerous non-eligible coupons may be presented to the customer at the point-of-sale.

Conversely, in the claimed invention, the e-coupons complying with redeeming conditions are checked to determine if two or more e-coupons can be used in combination within the same purchase; and thus, only coupons that can be used in combination within the same purchase can be displayed.

The Office Action argues that it would have been obvious to incorporate mutual exclusivity rules into the method and apparatus of Fajkowski. However, the Office Action does not cite any references that disclose using mutual exclusivity rules as an eligibility parameter.

The Office Action argues that the concept of coupon exclusivity has been admitted by Applicants as prior art (Office Action, p. 7 (citing p. 1 lines 21 – 22 of Applicants' disclosure)). Specifically, the portion cited by the Office Action provides that "[o]ften, coupons have mutual exclusivity constraints that restrict their use with other coupons".

This portion of Applicants' "Background" section broadly discloses the general concept of coupon exclusivity. Nevertheless, Applicants' Background section does not disclose that the prior art teaches a method wherein coupons are analyzed at the point-of-sale to determine applicability using eligibility parameters, wherein the eligibility parameters include mutual exclusivity rules. Rather, Applicants' Background section merely discusses disadvantages in the prior art.

In other words, the Office Action references a disadvantage of the prior art (i.e., mutual exclusivity constraints) that is noted in Applicants' background section and argues that it would have been obvious to analyze coupons for such a disadvantage.

However, the Office Action does not cite any references that disclose using mutual exclusivity rules as an eligibility parameter to determine applicability of coupons at the point-of-sale.

In addition, the Office Action argues that Beach also teaches user collection of e-coupons which are redeemed at the point-of-sale, wherein the coupons can be recommended to the user based on his user profile (Office Action, p. 7, para. 2). Thus, the Office Action asserts that it would have been obvious for one of ordinary skill in the art at the time of the invention to have suggested coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased (Office Action, p. 7, para. 2).

Once more, however, Beach fails to teach or suggest checking and displaying only coupons that are capable of being used in combination within the same purchase. Further, Beach fails to teach or suggest checking and displaying only coupons that satisfy optimization parameters defined by a user, or an optimization engine adapted to determine a subset of coupons dependent upon optimization parameters. The Office Action does not reference any portions of Beach that are directed to such features. Rather, the Office Action merely asserts that because Beach teaches recommending coupons to a customer, the recommendations "are taken to be optimal or near optimal recommendations" (Office Action, p. 7, para. 2). However, the coupons are not checked to determine whether they satisfy optimization parameters defined by a user.

Therefore, it is Applicants' position that the proposed combination of Fajkowski and Beach fail to teach or suggest the claimed feature of "checking said selection of e-

coupons ... to determine if said selection of coupons satisfy optimization parameters defined by a user”, as defined by independent claims 1, 8, and 15 or “determining if said computed set of e-coupons ... satisfy optimization parameters defined by a user” as defined by independent claims 22, 36, and 49. Further, it is Applicants’ position that Fajkowski fails to teach or suggest the claimed feature of “an optimization engine adapted to determine a subset of coupons ... dependent upon optimization parameters” as defined by independent claim 62.

In addition, because the proposed combination of Fajkowski and Beach fail to disclose optimization parameters, and particularly checking for and displaying coupons based upon optimization parameters, it is Applicants’ position that Fajkowski and Beach fail to teach or suggest the claimed feature of “optimization parameters comprising at least one of a discount amount, loyalty points, a number of free items received, earmarked coupons, non-earmarked coupons, expiration date, and a total number of coupons used” as defined by independent claims 22, 36, 49 and dependent claims 67, 68, 69, 70.

Because the proposed combination of Fajkowski and Beach also fail to disclose checking and displaying only coupons that are capable of being used in combination within the same purchase, it is Applicants’ position that Fajkowski and Beach fail to teach or suggest the claimed feature of determining if e-coupons “can be used in combination within the same purchase ... [and] displaying only said ... e-coupons ... capable of being used in combination within the same purchase” as defined by independent claims 1, 8, 15, 22, 36, 49, and 62.

Therefore, it is Applicants' position that the proposed combination of Fajkowski and Beach do not teach or suggest many features defined by independent claims 1, 8, 15, 22, 36, 49, and 62 and that such claims are patentable over the prior art of record. Further, it is Applicants' position that dependent claims 2-5, 7, 9-12, 14, 16-19, 21, 23-31, 33-35, 37-44, 46-48, 50-57, 59-61, and 64-73 are similarly patentable, not only because of their dependency from a patentable independent claims, but also because of the additional features of the invention they defined. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

IV. Formal Matters and Conclusion

With respect to the rejections to the claims, the claims have been amended, above, to overcome these rejections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.


In view of the foregoing, Applicants submit that claims 1-5, 7-12, 14-19, 21-31, 33-44, 46-57, 59-62, and 64-73, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any

deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

Dated: 7/28/06


Duane N. Moore
Registration No. 53,352

Gibb I.P. Law Firm, LLC
2568-A Riva Road, Suite 304
Annapolis, MD 21401
Voice: (410) 573-6501
Fax: (301) 261-8825
Customer Number: 29154

09/772,244

35